

No. 16132

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

JAMES MOON, EDMOND M. WAGNER and PHILIP SUBKOW,

Appellants-Cross-Appellees,

vs.

CABOT SHOPS, INC., and HOWARD SUPPLY COMPANY,

Appellees-Cross-Appellants.

CROSS-APPELLEES' REPLY BRIEF.

PHILIP SUBKOW,

727 West Seventh Street,
Los Angeles 17, California,

*In Propria Persona and Attorney
for Cross-Appellees.*

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CROSS-APPELLEES' REPLY BRIEF.

I.

The Issues on the Cross-Appeal Relate to Validity of the Patent and Were Limited by the Pretrial Order.

As a preliminary to the consideration of Cross-Appellants' Brief it is important to recall:

(1) That this is an appeal from a judgment holding the claims of the patent valid:

(a) as directed to an inventive advance over the cited prior art, as shown in Exhibits M through S and in T, *i.e.*, as contained in Exhibit T-1;

(b) as not disclosed in the aforesaid patents and printed publications more than one year prior to applicant's filing date; and

(c) specifically that it does not appear from the evidence that the devices described in the printed publications embody the invention of the patent in suit, the details not being apparent from the advertisements [Exs. M through R; Findings of Fact and Judgment, R. pp. 88-90];

(2) That the question as to whether or not the claims are to be construed to include or exclude Cross-Appellants' drive-in units are outside the issues of this cross-appeal. It is the issue in Cross-Appellees' appeal and it is discussed in the Appellants' Opening Brief;

(3) That the issue as to the validity of the patent was fixed by a pretrial order and limited to two main issues: Issue 1, in two parts, raised the issue of novelty over certain patents and publications identified in the Answers to Plaintiffs' Interrogatories, under Section 102(b) of Title 35 U. S. C., and Issue 2 raised the issue of invention over the same patents and publications under Section 103 of Title 35 U. S. C. [R. pp. 62 and 63]:

(a) That the patents and publications referred to in the Answers to the Interrogatories made prior to the Pretrial Order signed March 3, 1958 [R. pp. 25-27], are those Exhibits M-S and T [see App. Op. Br. pp. 2-7, and R. pp. 25-27, 62-63, 86 and 87].

Defendants, after the signing of the Pretrial Order, in their further Answers to Interrogatories filed March 21, 1958 [R. p. 85], included the patents "which appear in connection with Exhibit T." The order was never amended nor was there any application for its amendment.

Thus all other defenses under issues other than as formulated in the Pretrial Order were waived and the action was tried on these limited issues. The Cross-Appel-

lants are bound by this order. (*Harry X. Bergman, et al. v. Aluminum Shingle Corp. of America* (9th C. C. A., 1958), 251 F. 2d 801 at p. 802; *Johnson v. United States* (9th C. C. A., 1951), 193 F. 2d 969 at pp. 970-971; *Fowler v. Crown Zellerbach Corp.* (9th C. C. A., 1947), 163 F. 2d 773; *Fernandez v. United States Fruit Co.* (2nd C. C. A., 1952), 200 F. 2d 414, *cert. den.* 73 S. Ct. 797, 345 U. S. 935, 97 L. Ed. 1363; *McCarthy v. Lerner Stores Corp.* (D. C. of D. C., 1949), 9 F. R. D. 31; *Clark et ux. v. United States* (D. C. Dist. of Ore., 1952), 13 F. R. D. 342, at p. 344.)

(4) Further and in conformance with the Pretrial Order, the factual issues were limited by the limitation imposed on the prior art offered by Cross-Appellants in Exhibit T-1. These were offered and received into evidence only for purposes of aiding the interpretation of the file wrapper and not on the issue of validity and were accepted into evidence for this limited purpose only [R. pp. 300-302, 362-365].

They are thus for this additional reason not available for any other purpose and they are not available on the issue of validity. (88 C. J. S. p. 195, Sec. 87; *Island v. Fireman's Fund Indemnity Co.* (1947), 30 Cal. 2d 541 at p. 546, 183 P. 2d 153.)

The McEwen patent [R. p. 898 and referred to at p. 3 of Cross-Appellants' Br.] is part of Exhibit T-1 and not of Exhibit S and thus the issue as to whether the Moon patent is invalid as a mere reversal of the parts of the McEwen patent is outside the issues on this appeal. We will discuss the merits of Cross-Appellants' argument at another place herein.

The patent to Evans is not competent evidence on the issue of validity under the issues as formulated, since it

was patented and published on November 15, 1949, after the date of invention and after the filing date of the patent June 28, 1948. We have shown in our Opening Brief that this patent neither discloses the claimed invention nor has any pertinency on the issue of invention (see Appellants' Op. Br. pp. 7 and 68).

The Exhibits M-R are competent evidence only on the issues under Section 102(b) of Title 35 U. S. C. The Court found correctly that they do not disclose the invention. We will show below that they are of dates less than one year prior to the effective filing date of the patent in issue (see Appellants' Op. Br. p. 65).

II.

The Presumption of Validity and the Findings of Fact and Judgment of Validity Impose a Burden on Cross-Appellees to Show That the Findings and Judgment Are Clearly Wrong and to Establish the Invalidity of the Patent Beyond a Reasonable Doubt.

(1) Further, we wish to point out that the Trial Court's judgment was based on certain specific findings of fact based on the evidence presented in Court and on admissions of fact stipulated to be true in the stipulated Pretrial Order.

These findings are the statements adopted as findings by the Court [see Fdg. No. 2; see Pretrial Conference Order, p. 12, R. p. 60 incorporating the Pretrial Statement of Facts, R. p. 49]. The statements so incorporated are as follows: 2a and b, 3a-c, 4a, 5a-c [R. pp. 28 and 29]; 8 [R. p. 30]; 13a-b, 14a and b, 16a and b, 17 [R. pp 31 and 32]; 21a, 24a [R. pp. 34 and 35]; 48a and b, 49a-d, 50a, b, d and e [R. pp. 41-43]; 55A-D, H, I, J and L (a-d)

[R. pp. 45-47]; and see also Pretrial Conference Order No. 16 [R. pp. 60-61].

These findings of fact are thus to be taken together with the finding of fact that the patents and publications cited by Cross-Appellant do not anticipate the claims and that the claims are for an inventive advance over the prior art. (*Faulkner v. Gibbs* (9th C. C. A., 1948), 170 F. 2d 34 at p. 37, *aff'd* 338 U. S. 912, 70 S. Ct. 62, 94 L. Ed. 62, 83 U. S. P. Q. 192; *Maulsby v. Conzevoy* (9th C. C. A., 1947), 161 F. 2d 165 at p. 167 (quoted in Appendix p. 19); and *Ralph N. Brodie Co., et al. v. Hydraulic Press Mfg. Co.* (9th C. C. A., 1945), 151 F. 2d 91 at p. 94 (quoted in Appendix p. 10); *Refrigeration Engineering v. York Corporation* (9th C. C. A., 1948), 168 F. 2d 896.)

Cross-Appellants must show that these findings are clearly erroneous and must do so by showing that the record in this case makes them so clearly erroneous.

(2) To this we add that the burden of establishing the lack of validity rests on the Cross-Appellees. (*Bianchi v. Barili* (9th C. C. A., 1948), 168 F. 2d 793 at pp. 795-796 (quoted in Appendix p. 9).)

III.

The Contention That Moon by Cancelling His Claim 6 Admitted That His Invention Was Limited to a Particular Location of the Derrick Legs With Respect to the Driver's Position at the Front of the Chassis Is Without Merit.

While this may be material to the issues of infringement (see Appellants' Op. Br. pp. 77-97), it is not material on the issue of validity.

The contention stated at pages 4 to 6 of Cross-Appellants' Brief that by cancelling the broad claims by amend-

ment and by substitution of narrower claims, Moon admitted that his invention was limited to a particular location of the derrick legs as shown in Figure 3 of the patent, is certainly not correct. As was stated in *International Cellucotton Products Co. v. Sterilek Co.* (2nd C. C. A., 1938), 94 F. 2d 10 at p. 12 (quoted in Appendix p. 15), "When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element introduced." (See also, *Texas Co. v. Globe Oil & Ref. Co.* (D. C. N. D. Ill. E. D., 1953), 112 Fed. Supp. 455 at pp. 478, 483, *aff'd* 225 F. 2d 725 (quoted in Appendix p. 27); *Protective Closure Co. v. Clover Industries* (D. C. W. D. of N. Y., 1954), 129 Fed. Supp. 941.)

The fact of the matter is that contrary to the assertion of the Cross-Appellants, applicant always insisted that he was entitled to a claim broader than claim 1 of the patent and the Examiner finally allowed such claims 2-5. Cross-Appellant quotes out of context only a portion of the history of the prosecution. We have stated it fully in Appellants' Opening Brief, pp. 87-94. We call special attention to pages 91 and 92 of the Appellants' Opening Brief in which the report of the interview is given more fully than is reported by Cross-Appellants. We have analyzed and applied these claims to Cross-Appellants' drive-in structure in the Appellants' Opening Brief, pp. 53-63.

IV.

The Contention that Unless the Claims Are Limited to the Structure as Shown in Fig. 3 of the Patent, the Claims Are for an Obvious Reversal of the McEwen and White Devices Is Without Merit.

(See Cross-App. Br. pp. 4 and 5.)

Cross-Appellants state but advance no reason nor make any reference to anything in the record to support such a contention. No evidence was introduced at the trial to show that it would have been obvious to the man skilled in the art at the time of Moon's invention to obtain the patented invention by merely reversing the structure shown in White or McEwen. We have shown above that McEwen is not available to Cross-Appellants as evidence on this issue. It will be observed that this contention was also considered by the Patent Office in rejecting claims 14-17 [Ex. T-1, pp. 66-67], and the claims of the patent were subsequently allowed. We have discussed this in Appellants' Opening Brief at pages 91-93. This contention was first urged by Cross-Appellants in oral argument at the close of the trial [R. pp. 486-488]. It is significant to note that the White patent was not included by Cross-Appellants when it selected the best references [R. pp. 86, 128 and 368].

The Court found to the contrary [see Fdgs. 4, 5, 6 and 9, R. p. 89]. Cross-Appellants have not shown that these findings are clearly erroneous.

In fact, the evidence, both by testimony and by admissions, is clearly to the contrary and support the Court's findings as we discuss below.

V.

The Contention That Making the Legs "Straddle" the Driver's Position Was Not Invention Is Without Merit.

(See Cross-App. Br. pp. 5 and 6.)

We have shown in our Brief on Appeal on the Issue of Infringement that the position of the derrick hinge and the cooperating members with respect to the driver's position at the forward end of the chassis; the location of the derrick erecting means between the rear and front wheels and the location of the engine at the rear of the chassis all resulted in a safe, stable, legal and easily spotted unit. The old back-in units, such as shown in White and McEwen, did not and could not produce a safe, stable, legal and easily spotted unit. We have discussed the evidence, the admissions and the Pretrial Order on this point at pages 16-34 of Appellants' Opening Brief, see particularly pages 16-22 and 28-34 and reference is made thereto.

That this is clearly invention is further evidenced by the following which are fully established by the evidence and by admissions in the Pretrial Order:

A. Cross-Appellants, When They First Learned of Mr. Moon's Design, Were Skeptical of Its Practicability and Tried Various Other Schemes for Solving the Problem.

As early as September, 1946, Mr. Woody, Chief Engineer for Cross-Appellants, obtained, from sources unknown, information of a design which Mr. Moon was considering. Mr. Woody wrote a letter to the President of the Franks Manufacturing Corp., the predecessor of Defendant, Cabot Shops, Inc. This letter is in evidence as Exhibit 91. (It was Exhibit 49 and 49A of the Woody Deposition [see R. pp. 628 and 629].) This is admitted

by Cross-Appellants and found as a fact by the Court [Fdg. of Fact No. 2 incorporating Pretrial Order III(12) which incorporated Item 48(a) and (b) of Plaintiffs' Pretrial Statement, R. pp. 41 and 42].

This letter [Ex. 91, R. pp. 775-777] describes Moon's drive-in idea and is eloquent evidence of the novelty of the idea to Mr. Woody and also of his skepticism as to the practicality of the idea.

Mr. Woody testified the first step taken by Franks, to solve the problem of legality was to reduce the weight of the back-in unit. This failed [R. p. 599].

They next tried to modify the semi-trailer unit [see Ex. 85, originally Ex. 33 of the Woody Deposition], and this failed [R. p. 600].

They sought help from others who were also unsuccessful in their efforts. We have now reached the year about 1949, according to Mr. Woody, and by this time, as is admitted by Cross-Appellants, the competition from Wal-drip, the licensee under the Moon patent [R. pp. 214-216], forced them to again attempt to design a legal unit. They sought advice from the Dart Manufacturing Co., a builder of trucks. It is to be noted that defendants still use Dart trucks in their drive-in units [Ex. AA]. The Dart solution is shown in Trial Exhibit 70 (originally Ex. 19 of the Woody Deposition). Mr. Woody is entirely uncomplimentary of this design [R. pp. 523, 524, 620-624].

Franks sent an engineer named Mr. Auler to California to try to design a legal unit [R. pp. 603, 604]. He tried to modify the back-in unit in order to make it legal. He was entirely unsuccessful [R. p. 604]. This is admitted by defendants and found as a fact by the Court [Fdg. of Fact No. 2, incorporating Par. III(12) of the Pretrial

Order, incorporating Par. 49(a)-(d) of the Plaintiffs' Statement of Facts, R. p. 42].

According to Mr. Woody, Mr. Auler's design proved to be entirely impractical, not only because it made an entirely unsatisfactory design [R. p. 607] but also because it did not give much protection to the driver and could place the driver in serious danger [R. pp. 616, 617].

B. Defendants Built Their Drive-In Unit by Copying the Moon Design.

The design of the Defendants' drive-in unit was started by Franks in 1949 [R. p. 597], and the first unit was completed in 1952 [R. p. 598], taking 3 years to design and build this unit. Mr. Woody stated that the design was started after "exhausting the possibilities of other approaches."

Mr. Woody testified:

"Q. When did you start the design of the structure that was completed in 1952? A. Oh, the first work was probably done in '49 or maybe even before '49, and it was only initiated after exhausting the possibilities of other approaches, that is through trailer vehicles which were supposed to be an answer to the legal problem, but it developed that they are no solution of legality, and that the only conceivable way of producing the equipment that we were most hurt on and the industry was most hurt on, was to simplify and eliminate all duplications, and that is what we had in mind in attacking the problem. It wasn't just a new design. It was a development that was initiated by the highway enforcement officials" [R. p. 598].

And how were Cross-Appellants placed on the right track to the only "conceivable way of producing the equip-

ment” after its long history of failure to find the “way”? They did so after they obtained a copy of a confidential brochure issued by Waldrip, and learned of the details of Moon’s design, and they copied this design.

During the period of the design of the unit by Mr. Moon at Waldrip, he prepared a confidential brochure giving the details of this design, to be used and held confidential in the company and shown in confidence to customers. This brochure is in evidence as Exhibit H (it was Ex. 8 in the Moon Deposition) [see R. pp. 222, 223]. It gives the details of the design [see section under 321, Ex. H].

The following facts are admitted by Cross-Appellants and found as a fact by the Court:

“50. (a) During and prior to the completion of the design of the first Clipper unit by Franks they had learned of the Moon design of the drive-in unit manufactured by Waldrip.

“(b) They had obtained a copy of a brochure prepared by Moon for Waldrip” [Fdg. of Fact No. 2, incorporating Par. III(12) of the Pretrial Order incorporating Par. 50(a) and (b) of Plaintiffs’ Pretrial Statement of Facts, R. pp. 42-43].

How defendants obtained this brochure has never been explained [see Answer to Interrogatory XIV, Pltf. Ex. 102, R. p. 20].

Notwithstanding the skill and competence of the Franks organization, which had been manufactured and selling back-in units for many years prior to the Moon invention, they had been unable to solve the problems inherent in the back-in unit. They had been aware of its deficiencies for many years and tried and obtained the help

of others to try to solve the problem. Yet Cross-Appellants, who had not thought of Moon's drive-in invention, now say it was always obvious to them.

C. The Patented Structure Has Obtained a Large Commercial Success.

We have shown how the drive-in principle satisfied the engineering and legal requirements, whereas the back-in portable derricks did not. This was admitted as true by Cross-Appellants and found as a fact by the Court (see our discussion of this point in Appellants' Op. Br. at pp. 23-34). The ease of spotting was also an important feature. The result is a unit which satisfied the needs of the industry and has largely replaced the prior art portable derrick. We have discussed the point at pages 28-31 of Appellants' Opening Brief. Cross-Appellants have paid eloquent tribute to the drive-in principle in their advertising. We have quoted from these advertisements at pages 31-32 of the Appellants' Opening Brief.

These results derive from the drive-in principle and is so admitted by the Cross-Appellants and found as a fact by the Court [see Appellants' Op. Br. pp. 32 and 34, and Fdg. of Fact No. 2 incorporating Par. III(12) of the Pretrial Order incorporating Plaintiffs' Pretrial Statement of Fact, 55A-D, H-J and L, R. pp. 45-47].

The simple fact of the matter is that no one prior to Moon thought to abandon the old type of truck and to combine the derrick, hinge, engine and elevating mechanism in the patented fashion. This solution was not indicated by the prior art and produced a highly useful improvement as is established by the evidence discussed in Appellants' Opening Brief at pages 28-34 to which this Court is respectfully referred.

This amounts to invention. (*Pointer v. Six Wheel Corp.* (9th C. C. A., 1949), 177 F. 2d 153 at pp. 160-161 (quoted in Appendix p. 23); see also *Patterson-Ballagh Corp., et al. v. Moss, et al.* (9th C. C. A., 1953), 201 F. 2d 403 at pp. 405-406 (quoted in Appendix p. 21); *Stauffer v. Slenderella Systems of California* (9th C. C. A., 1957), 254 F. 2d 127 at p. 128 (quoted in Appendix p. 26).)

Whether a rearrangement of parts amounts to invention depends on the particular facts of the case. (Walker on Patents (Deller's Ed.), Sec. 33, p. 195; *Grever v. United States Hoffman Co.* (6th C. C. A., 1913), 202 Fed. 923 at p. 925 (quoted in Appendix p. 15); *Patterson-Ballagh Corp., et al. v. Moss, et al., supra*, at pp. 405-406 (quoted in Appendix p. 21).)

Was the drive-in unit an obvious variation of the back-in unit?

When the drive-in principle was first revealed to Cross-Appellants they were very skeptical of the workability of the idea. Now that it is successfully demonstrated, they say that it was always obvious.

The law has other tests and Cross-Appellants' skepticism when they first heard of the idea is eloquent evidence of the non-obviousness of the solution. (*Zonolite Co. v. United States* (U. S. Ct. of Cl., 1957), 149 Fed. Supp. 953 at p. 957; *Brown v. Brock* (4th C. C. A., 1957), 240 F. 2d 723 at p. 727.)

The above evidence establishes that the need for solution of the problems presented by the back-in unit was long known to the trade, as well as to Cross-Appellants, that Cross-Appellants tried various solutions and failed and that not until they copied the patented unit, by obtaining a confidential bulletin prepared by Moon, were they able to

design a stable, safe, legal and easily spotted drive-in unit. That such units have been widely accepted and displaced the back-in units is established by the above evidence (Appellants' Op. Br. p. 30). If there be any doubt as to validity this circumstance should weigh heavily in the patent's favor. (*Safety Car Heating & Lighting Co., Inc. v. General Electric Co.* (2nd C. C. A., 1946), 155 F. 2d 937 at p. 939 (quoted in Appendix p. 26), cited and quoted in *Pointer v. Six Wheel Corp., supra*, at p. 162; *Florence-Mayo Nuway Co. v. Hardy* (4th C. C. A., 1948), 168 F. 2d 778 at pp. 781-782 (quoted in Appendix p. 13), cited and quoted in *Filtex Corporation v. Amen Atiyeh* (9th C. C. A., 1954), 216 F. 2d 443 at p. 445; see also, *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 428, 435, 31 S. Ct. 444, 55 L. Ed. 527 at p. 532.)

The Cross-Appellants who succeeded in solving the problem they had theretofore been incapable of solving, only by copying the Moon structure, having first obtained a confidential bulletin disclosing the design, now state that it was always obvious. The facts are certainly persuasive evidence of its unobvious character. (*Florence-Mayo Nuway Co. v. Hardy, supra*; *Kurtz v. Belle Hat Lining Co.* (2nd C. C. A., 1922), 280 Fed. 277 at p. 281 (quoted in Appendix p. 17).)

VI.

The Contention That the Waldrip Advertisements Disclose the Invention Is Without Merit.

(Cross-App. Br. pp. 6-12.)

It should be noted that the Trial Court's Findings Nos. 4, 5 and 6 were made after testimony was introduced by way of expert evidence by Cross-Appellants. This testimony was conflicting and the findings were made by resolution of this conflicting testimony and after weighing the

credibility of the evidence against the disclosure in the advertisements themselves. We discuss this below.

That the publications were advertisements intended to stimulate an interest in the Waldrip portable derrick and not disclosures of the construction of the devices appears from the advertisements.

In appraising their evidentiary value on the issue of validity, it must be remembered that they are not competent evidence on the issue of the presence or absence of invention under Section 103 since they were published at a date later than the date of invention, December 12, 1946.

They were offered and received as anticipating novelty under Section 102(b).

In such case these advertisements are each competent evidence only of what can be *read in them* and not on what *may be read into them* as being necessary or desirable because of the experts' additional knowledge and experience. They must describe the identical invention claimed in the patent.

This requirement is predicated upon the express language of the statute which states in Section 102 that:

“a person shall be entitled to a patent unless the invention was * * * described in a printed publication before the invention thereof by the applicant for patent (Sec. 102(a)) * * * or more than one year prior to the date of the application. (Sec. 102(b).)”

Section 103 states that if the invention *is not identically disclosed or described* as set forth in Section 102 then the patent must stand the test of Section 103 which will be discussed later on.

On logical and established rules of statutory construction Section 102 and Section 103 must be read together and all the words given meaning.

82 C. J. S., Sec. 348.

Section 103 qualifies Section 102 in this respect. This has always been the law and the purpose of the enactment of the Patent Act of 1952 was for the purpose of clarifying and specifying this distinction between the defense of novelty under Section 102 and the defense of lack of invention under Section 103. This is made clear by the Report of the Committee on the Judiciary submitted May 12, 1952 (see Reviser's Note, U. S. C. A., Sec. 103, p. 715), in which the Committee in describing Sections 102 and 103 had the following to say with respect to Section 103:

“Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the court. An invention which has been made, and which *is new in the sense that the same thing has not been made before*, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writing. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, *meaning what was known before as described in Section 102*. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented” (emphasis added).

Sections 102(b) and 103 thus merely codify what has long been the interpretation placed by the courts on the requirements of the law with respect to evidences of lack of novelty as distinguished from lack of invention.

As was stated by this Court in *Stauffer v. Slenderella Systems of California*, *supra*, at p. 128:

“Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical functions as a prior pleaded patent, there is no anticipation.”

(See also, *Alexander Anderson, Inc. v. Eastman Oil Survey Co. of Cal.* (D. C. S. D. of Cal. C. D., 1936), 16 Fed. Supp. 513 at p. 522 (quoted in Appendix p. 8); *Crowell v. Baker Oil Tools* (9th C. C. A., 1946), 153 F. 2d 972 at p. 973; *Jacuzzi Bros., Inc. v. Berkeley Pump Co.* (9th C. C. A., 1951), 191 F. 2d 632 at p. 637 (quoted in Appendix p. 17); *Lincoln Stores, Inc. v. Nashua Mfg. Co.* (1st C. C. A., 1946), 157 F. 2d 154 at p. 160, *cert. den.* 329 U. S. 811, 67 S. Ct. 623, 91 L. Ed. 692 (quoted in Appendix p. 18); *Balaban, et al. v. Polyfoto Corp.* (D. C. D. of Del., 1942), 47 Fed. Supp. 472 at pp. 477 and 478 (Appendix p. 9).)

The distinction between the defense of novelty and defense of lack of invention is explained in *Walker on Patents* (Deller's Ed.), Vol. 1, pp. 254 and 255 (quoted in Appendix p. 7).

The publication must give the same directions as does the patent. (*Cold Metal Process Co. v. Carnegie-Illinois Steel Corporation* (3rd C. C. A., 1939), 108 F. 2d 322, 323, *cert. den.* 309 U. S. 655, op. withdrawn upon stip. 115 F. 2d 33 (quoted in Appendix p. 11).)

The publication must itself give the requisite information and extrinsic evidence may not be employed to supply deficiencies in the publication. (*Permutit Co. v. Harvey Laundry Co.* (2nd C. C. A., 1922), 279 Fed. 713 at p. 719; *cert. den.* 259 U. S. 588 (quoted in Appendix p. 23); *J. A. Mohr & Son v. Alliance Securities Co.* (9th C. C. A., 1926), 14 F. 2d 799 at p. 800 (quoted in Appendix p. 20).)

Nor is a publication an anticipation if it must be altered or features supplied to accomplish the results of the patent even though the alterations appear obvious. (*Bianchi v. Barili* (9th C. C. A., 1948), *supra*, at p. 796 (quoted in Appendix p. 9); *Line Material v. Brady Electric & Mfg. Co.* (D. C. D. Conn., 1924), 299 Fed. 882 at p. 824, *aff'd* 7 F. 2d 50; *Trico Prod. Corp. v. Ace Prod. Corp.* (D. C. D. of Conn., 1929), 30 F. 2d 688, 691; *United Shoe Machinery Corp. v. Mathey* (1st C. C. A., 1941), 117 F. 2d 331 at p. 332.)

This is particularly true where the publication is in the form of a drawing. (*Trussell Mfg. Co. v. Wilson-Jones Co.* (2nd C. C. A., 1931), 50 F. 2d 1027 at p. 1029 (quoted in Appendix p. 29).)

The case of *Willamette-Hyster Co. v. Pacific Car & Foundry Co.* (9th C. C. A., 1941), 122 F. 2d 492, 497, quoted by Cross-Appellants at page 13 of their brief, is not apposite. The Court found as a fact that the claims of the patent claimed the structure broadly and every element of the claims so broadly claimed was found in the prior art. The patent in that case was claimed to be a basic patent (p. 495). The elements of the claims are illustrated at page 495. The Court found in the publication every element of the claims. Its comment that the prior publication is as definitive as the patent relates to

the application of mechanical and engineering skill necessary to construct the device from the disclosed invention. The Court concluded that no more was required of the publication (p. 497). The case is not authority for any proposition that a publication is an anticipation, if elements of the claims not present in the disclosure may be supplied by the exercise of engineering or mechanical skill.

In the present case, the elements are claimed specifically and many of these elements are not found in the advertisements.

A. Exhibits M and N.

The following elements of the claims are not to be found described or shown in the Exhibits M and N.

Item: The four-legged derrick specified in all the claims with two legs on each side of the driver's position is not shown.

Only a side view is shown in these exhibits and thus only two legs appear. It cannot be seen whether the two legs shown in the picture are above to one side of the cab or above and over the top of the cab.

Item: The hinge positioned on the derrick and on the chassis is not shown.

The derrick in the exhibits may be just resting on top of the cab to be removed in some undisclosed way.

Item: The hinge support [claim 4, item Ia, R. p. 653] or the means [see claim 5, Item L and its subdivisions, R. p. 656] which place the legs in load transference relation to the ground and positioned on each side of the hinge supporting framework is not shown in the exhibits.

Item: The hinging of the erecting means to the chassis between the rear and front wheels is not shown in the exhibits nor its hinging to the derrick.

Something is shown extending downward from the derrick near the top of the derrick behind the rear wheels and also between the front and rear wheels. What they are is not disclosed. The derrick may be just supported on these elements to be removed by some undisclosed means.

B. Exhibit O.

This exhibit has the same deficiencies as Exhibits M-N. An inspection of the perspective view in the upper left-hand corner will show that the derrick is not hinged to the chassis above the driver's position. The exhibit as reproduced in Cross-Appellants' Brief at page 29 is on a reduced scale, and the absence of a hinge is directly obvious even from this reduced scale reproduction. The space between the derrick legs and the top of the cab is clear and there is no connection between the derrick and the cab or chassis above the driver's position.

C. Exhibit P.

What has been said of Exhibits M-O applies to Exhibit P. Cross-Appellants have referred to the trademark at the lower left of the drawing arguing that this trademark makes the disclosure of a four-legged derrick obvious, pointing to Mr. Groner's testimony. Ignoring for the moment the fact that Mr. Groner testified that [R. pp. 401-402] he could see only a two-legged derrick and if it were a two-legged derrick it could be erected on the side of the chassis, the evidence in this case shows the following:

That the lower picture is a trademark employed by Wal-drip in connection with various portable derricks including the two-legged derricks [see Ex. 17, R. pp. 180-181].

Cross-Appellants point to the trademark as showing that the structure in the upper picture has pivoted about a point over the steering wheel. If the trademark is closely inspected, it will be seen that the diagonal between the upper

and lower leg terminates adjacent the lower leg in the upper picture. However, in the trademark this diagonal terminates at this leg at a point below the top of the cab. If this picture discloses anything, the intersection between the diagonal and the bottom leg is shifted downward in comparison with the position in the upper picture. This is inconsistent with the presence of a hinge between the derrick and the top of the cab.

The truth of the matter is that the lower picture in Exhibit P and the upper picture in Exhibit 17 are trademarks and a very sketchy artist's rendering which by their very nature are not descriptive. No one would look to them for engineering information.

We wish to say one more thing with respect to two-legged derricks and that is that there are two-legged derricks in the form of double pole masts as appears from the evidence [see upper lefthand corner, p. 1830 of Ex. 55]. Their existence is further established by the admissions made by Cross-Appellants in the Pretrial Order and in the Findings of Fact [Fdg. of Fact No. 2, incorporating Par. III(12) of the Pretrial Order incorporating Par. 8, R. p. 30]. Other types of latticed two-legged telescopic derricks are also known [see Ex. 17].

The fact that Mr. Groner did not know of this type of oil field mast is simply that he is admittedly not familiar with the art to which the invention pertains. We discuss this below.

D. Exhibits Q and R.

These advertisements suffer from the same infirmities and are of no greater pertinency than Exhibits M-P. They are not even discussed in Cross-Appellants' Brief.

In addition to the publications themselves, two expert witnesses testified on behalf of the Cross-Appellants.

E. Mr. Purdum's Testimony.

Defendant offered Mr. Purdum as an expert to read the advertisements [Ex. M]. Mr. Purdum was unable to distinguish between what was described in the advertisements and what, from his experience in this art and from his study of the patent in suit, he felt was obvious to him and "must" be contained in the structures pictured in the advertisements, if they were to be an operative drive-in unit, with the derrick hinged at the front of the vehicle.

This was admitted by the Cross-Appellants at the trial and in their brief at page 11.

Mr. Lyon [R. pp. 388-389], in introducing Mr. Groner, stated:

"The point of the whole thing, your Honor, is that Mr. Subkow would quite properly argue that Mr. Purdum is an expert in this art, that he knows all about the patent in suit, and knows all about the accused device, and can take the drawings and find the various elements of the patent, because he knows what would be done. But here is a man absolutely innocent of that special knowledge, and I want to show you he can do as good a job of that as Mr. Purdum did."

It was simply impossible for Mr. Purdum to disassociate himself from what subjectively he thought would be obvious to him as required to complete the structure shown in the advertisements to produce what he had seen in the patent.

The following appears on page 445 of the Record:

"Q. Now, Mr. Purdum, don't you think it's a fair statement that, taking that drawing and reading it, you have read into it not only what there is in it but what your experience and knowledge with the prior

art would supply to that drawing to supplement what is not there? A. I believe it would be a little difficult to separate the knowledge that one has from, on (*sic*) from the other. I imagine that I did draw on some of the things that I know to be mechanical expedients and ordinarily used in machine design."

It is to be remembered that Mr. Purdum came to the conclusion that there was a four-legged derrick present which was wider than the cab because he had also come to the conclusion that the derrick was hinged [see R. p. 380].

Mr. Purdum's reasoning appears to be as follows:

(1) The mast is hinged. The hinge is, Mr. Purdum admits, "real small," but he sees it [R. p. 376]. He admitted, however, that he saw a hinge because he saw a contact between the derrick and the cab top at one point. He agreed it could be merely a rest support [R. p. 444].

(2) That while the derrick shown is two-legged, it must be four-legged, for otherwise, since it is hinged, it couldn't pass outside of the cab [R. p. 380].

(3) Although a hinge support is not shown, there must be a hinge support, because, from his experience, in order to hinge the derrick some support other than the cab must be provided [R. p. 443].

(4) He concludes that the derrick is hinged because he sees what he interprets to be a jack and he interprets the drawing from his experience of the prior art to mean that the jack must be pivoted at its lower end and therefore in order for the jack to rotate at its lower end, the derrick must be hinged [R. pp. 444-445].

This reasoning and argument not only assumes the answer, but requires the expert to resort to his knowledge

and to add to the disclosure in the patent. Mr. Purdum was reading the drawing by *reading into it* what he felt from his experience *he would place in the drawing to make it do what the patented structure did.*

This is impermissible under Section 102(b) (see *supra*). Mr. Purdom's testimony thus raised the issue as to credibility of Mr. Purdum's testimony that he saw a four-legged derrick with the legs on each side of the cab, hinged on a support mounted on the chassis with a jack hinged to the derrick and to the chassis between the rear and front wheels.

It required the resolution of the conflict in his testimony in which, on direct examination, he stated he saw some of the elements of the claims in the advertisements and his testimony on cross-examination that he read these elements into the advertisements, not because they were there, but because from his experience he knew it would be necessary to have them there and obvious to him to supply them.

The Court having the advertisements before it, and appraising the credibility of the testimony as to what the advertisements showed and resolving the conflict in the testimony, found that the advertisements did not disclose the invention, a finding of fact which Cross-Appellants have not shown to be erroneous.

F. Mr. Groner's Testimony.

We now come to Mr. Groner's testimony. Mr. Groner was offered as one who, while expert in aircraft fuel pumps, has no skill in or knowledge of the art to which the invention pertains [see R. pp. 387-388].

Mr. Groner's testimony establishes that he was unable to read in these advertisements [Exs. M-R] the presence of a four-legged derrick which was wider than the cab

and was hinged to the chassis. On his direct examination, Mr. Groner identified the jack and stated that the derrick was hinged [see R. p. 391]. Mr. Groner, upon his cross-examination, changed his mind as to the showing of a hinge between the derrick and the vehicle.

He testified on cross-examination that he could not tell from the Exhibits M-N and P-R, whether the advertisements showed a two-legged or a four-legged derrick since all he could see was two legs. While he could only see a two-legged derrick, he stated this two-legged derrick need not be necessarily within the lateral sides of the cab; that it could be on either side of the cab or on top of it. He stated he could not tell from the picture whether "this two-legged derrick" was on the side of the truck or on top of the truck [R. pp. 401-402].

However, he testified, his doubts were resolved when he looked at Exhibit O. He stated that Exhibit O gave him the same information that all of the other exhibits [Exs. M, N, P-R] gave him, and in addition gave him the additional information which completed his knowledge and that this additional information was that the derrick was four-legged [see R. p. 402].

However, when he reviewed the pictures of Exhibit O after the picture in the upper lefthand corner was called to his attention, he conceded that no hinge was shown and he could not tell whether the derrick was wider than the cab [see R. p. 403].

The point made by Mr. Groner is clearly shown, even on the reproduction of Exhibit O in reduced scale included in Cross-Appellants' Brief at page 29 (see the clear white line between the derrick and the top of the cab in the upper left-hand perspective view).

Mr. Groner's testimony thus raised the same issue as to the credit which may be attached to his testimony that he saw the elements of the claims in the advertisements and required the resolution of the conflict in his testimony given on direct examination and his testimony on cross-examination as to the presence of a four-legged derrick hinged to the chassis above the driver's position.

The Court's finding referred to above answered the question as to the credibility of this witness' testimony and resolved the conflict by finding that in view of the evidence these advertisements did not disclose the invention.

VII.

The Contention and the Court's Conclusion of Law That the Filing Date of the Patent Cannot Be Carried Back to a Period of Time Less Than One Year Prior to the Date of the Advertisements Is Clearly Erroneous.

This issue arises because of earlier filed applications by Moon [Exs. 44, 45 and 46, the last having been filed February 24, 1948] which make the advertisements incompetent evidence of anticipations under Section 102(b). We discuss the facts below.

The Court found as a fact that the reference to these applications does not appear on the face of the patent and as a matter of law that the Moon patent was not entitled to the dates of filing of these earlier applications [R. pp. 89 and 90]. This conclusion became moot when the Court decided that the advertisements did not disclose the invention. It becomes material, thus, only if this Court should find to the contrary.

We will first analyze the pertinent statutes and the decisions to show that the Court misapplied the law to the facts of this case.

Our position is that the right of the patent in issue to refer back to previous applications for its effective filing date is not dependent on Section 120 but arises under Revised Statute Section 4886 in force when the Moon application was filed on June 28, 1948, and that under that statute no reference to the earlier applications is required.

The patent application was pending when the Patent Act of 1952 (Public Law 593, 82nd Cong. 2nd Sess., Chap. 950, 66 Stat. 792) was enacted. This act (Public Law 593) is in five sections (Sec. 485, quoted in Appendix p. 1). Section 4 of the act provides under subsection (a) that the act shall take effect on January 1, 1953, and

“* * * shall apply to all applications for patents filed on or after such date and to all patents granted on such application. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications *except as otherwise provided*. It shall apply to unexpired patents granted prior to such date except as otherwise provided” (emphasis added).

Section 5 of the act repeals the sections of the Revised Statutes and Statutes at Large codified in this act with the proviso that “*Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.*” One of the sections so repealed is the Revised Statute Section 4886 upon which Sections 101 and 102 of the Patent Act of 1952 are predicated. Moon, at the time of the repeal of Revised Statute Section 4886, had a right under Section 4886 to rely on the earlier applications for his effective filing date without specific notice in his application of the earlier applications. This saving clause specifically preserves that right for him.

We have been unable to find any case predicated upon the factual situation here presented. However, we have found a case upon a similar situation in which the retroactive effect of the Patent Act of 1952 was considered. (See *Diebold, Inc. v. Record Files, Inc.* (D. C. N. D. Ohio E. D., 1953), 114 Fed. Supp. 375 at p. 376 (quoted in Appendix p. 12).)

Under Revised Statute 4886, Section 31 of Title 35, U. S. C., then in effect, and under the decisions interpreting this statute, Moon on filing his application and certainly up to January 1, 1953, had the right to rely on the earlier applications for his effective filing date. (*The Suffolk Company v. Hayden*, 3 Wallace, 70 U. S. 315 at pp. 318 and 319; *General Picture Corp. v. Western Electric Co.*, 304 U. S. 175 at p. 183, 58 S. Ct. 849, 82 L. Ed. 1272; *Veaux v. Southern Wagon Sales* (D. C. D. Ore., 1940), 33 Fed. Supp. 605, *aff'd* 123 F. 2d 455; *General Electric Co. v. Independent Lamp & Wire Co.* (D. C. D. N. J., 1920), 267 Fed. 824 at p. 836; *Badische Anilin & Soda Fabrik v. Kalle & Co., et al.* (2nd C. C. A., 1900), 104 Fed. 802; *Victor Talking Mach. Co. v. American Graphophone Co.* (C. C. S. D. of N. Y., 1905), 140 Fed. 860; *Victor Talking Mach. Co. v. American Graphophone Co.* (2nd C. C. A., 1906), 145 Fed. 350; *Victor Talking Mach. Co. v. Duplex Phonograph Co.* (C. C. W. D. Mich. S. D., 1909), 177 Fed. 248; *Jacquard Knitting Mach. Co. v. Ordinance Gauge Co.* (D. C. E. D. Penna. 1951), 95 Fed. Supp. 902; *Jacquard Knitting Mach. Co. v. Ordinance Gauge Co.* (D. C. E. D. Penna., 1952), 108 Fed. Supp. 59 at p. 67; *Jacquard Knitting Mach. Co. v. Ordinance Gauge Co.* (3rd C. C. A., 1954), 213 F. 2d 503; *Harder, et al. v. Hayward* (C. C. P. A., 1945), 150 F. 2d 256; see also: Manual of Patent Examining Procedure, issued by

U. S. Patent Office, Ed. of Nov. 15, 1949, Secs. 201.08 and 201.11 (quoted in Appendix p. 5).)

Applications filed under the Patent Statutes prior to the Patent Act of 1952 were entitled to the benefit of the filing date of prior applications without specific reference thereto in the application. (*Ex parte Roberts*, 1887 C. D. 61-64, 40 O. G. 573 (quoted in Appendix p. 24); *Timken-Detroit Axle Co. v. Eaton Axle & Spring Co.* (D. C. N. D. Ohio E. D., 1931), 56 F. 2d 651 at pp. 651-652 (quoted in Appendix p. 28); *Ex parte Clarke* (P. O. Board of Appeals, 1953), 97 U. S. P. Q. 165 at p. 172.)

The above rules of law make Exhibits M through R incompetent as evidence under Section 102(b) of Title 35 because of the pendency of earlier filed applications.

The basis of our contention is the fact that prior to April, 1947, Moon had filed a series of patent applications [Exs. 44, 45 and 46]. The only question with respect to these applications arises from the fact that the printed patent in issue here does not carry a reference to these applications. It has never been contended by Cross-Appellants that Moon would not be entitled to these filing dates for any reason other than the absence of such notice in the printed patent.

Application Serial No. 776,631, filed September 29, 1947; now Patent No. 2,662,797 [Ex. 44, R. pp. 685-702]. This application is noted on the file jacket of the patent in suit [Ex. T-1] and can be seen under the certification when the certificate is lifted. It is covered up in the reproduction in the Appendix to Cross-Appellants' Brief, page 33.

Application Serial No. 785,165, filed November 10, 1947; now Patent No. 2,565,777 [Ex. 45, R. pp. 703-771].

Note the binders have disarranged the pagination of Exhibit 45 in Volume III of the Record.

Application Serial No. 10,412, filed February 24, 1948 [Ex. 46]. It became abandoned July 27, 1953, by failure to respond to the office action of January 26, 1953. The exhibit is not in the Exhibit Book, Volume III; pertinent parts of the exhibit are printed in the Appendix to this brief at pages 31.

Reference to Figures 1 to 4, and page 4 of the specification of Exhibit 46 (see Appendix p. 34) will show that this application discloses the mounting of the derrick on a hinge adjacent the front of the truck and above the driver's position in the cab. Specifically it discloses the extending jack hinged to the derrick and to the chassis between the front and rear wheels. It discloses one of the trusses which carry the hinge and which the specification states are positioned on each side of the derrick. It refers to the application Serial No. 776,631 [Ex. 44; see drawings, R. p. 752, and the specification, p. 736 *et seq.*, particularly p. 739].

Application Exhibit 44 describes the mounting frame shown as 3 on Figure 1 and states [see p. 4 of the specification Ex. 44, R. p. 691] that this mounting is also shown in application Serial No. 35,666 (the patent in suit) and in application Serial No. 10,417 [Ex. 46].

The disclosures of the above exhibits are much more complete disclosures than the advertisements and show elements of the claims which are omitted from the advertisements. If the advertisements disclose the invention, which we have shown above is not true, certainly these prior filed applications do so much more completely.

Since each of these applications was filed prior to the filing of the application for the patent in suit and was pending when the application was filed and when the publication of the advertisements was made, Exhibits 44, 45 and 46 were filed less than one year from the earliest advertisement [Ex. Q, April 1947].

If, as we believe is so, the law permits Moon to have the benefit of the filing dates of these applications for all common subject matter, then these three earlier applications make the advertisements of no competent value not only because they do not disclose the invention of the patent, as required by Section 102(b) but also, if they are construed to disclose the invention, then they are *not early enough* in time as required by that statute. They are less than a year prior to the date of these earlier applications and are later than the date of Moon's invention, December 12, 1946 (see Appellants' Op. Br. p. 4).

VIII.

The Contention That the Patented Drive-In Unit Lacks Invention Over the Morton Patent, the Downie Patent and the Evans Patent Is Without Merit.

We have previously in this brief shown that the Evans patent is not competent evidence on this issue in view of the Pretrial Order. The Evans patent has no teaching which is of any utility in designing a portable oil well servicing derrick. We respectfully refer the Court to the discussion at pages 67 and 68 of the Appellants' Opening Brief, where this patent and the evidence given with regard thereto is discussed.

The Morton patent 966,346 is also discussed at pages 66 and 67 of the Appellant's Opening Brief and need not

be repeated here. We wish to point out here, however, that while the Morton patent was not cited by the Examiner, a closely similar patent, *i.e.*, the Preston patent 414,578 [see Ex. T-1, R. p. 940] was cited.

Both patents relate to horse-drawn fire wagon ladder trucks. The ladders are both hinged in the same manner. Compare Figures 1 and 9 of the Preston patent (Item (d), lower end of Fig. 1) with the hinge 49 of Morton Figures 2, 7 and 24. The driver sits on top of the ladder in both patents (see R in Preston Fig. 1 and seat 400 of Morton Figs. 2 and 10). The hinge is positioned below the driver's position in both cases. The Examiner withdrew the Preston reference and did not rely on it in any of the following actions [see the Examiner's action, April 25, 1952, p. 42 of Ex. T].

The Downie patent was discussed by us in the Appellants' Opening Brief, page 69. The Court is respectfully referred to that brief for the discussion.

None of the above patents have any teaching which has any utility in solving the problem of stability, safety, legality or of spotting solved by the drive-in unit.

A. There is no teaching that the cab should be placed at the head of the chassis and the engine which drives the truck be placed at the rear.

Morton's driver is at the front of the vehicle where he holds the reins of the horses. He backs the wagon against the curb or draws up alongside the curb (see Appellant's Op. Br. p. 67). While it is suggested other motive power may be employed, how this is to be accomplished is not suggested. Downie has no driver or engine for driving his wagon and Evan's driver is in the middle of the tractor.

B. There is no teaching that the derrick should be hinged above the driver so that two legs and the cooperating positioning members are on each side of the driver. Morton's ladder is hinged below the driver and is not erected on the ground, and in Downie there is no driver's position. In Evans the rails on which the lift operates are not spread wider than the driver's position and obscure his vision.

C. There is no teaching of any erecting means hingedly connected to the chassis and to the lower end of the derrick spaced from the hinge.

It will be remembered that this mechanism contributes to the stability of the structure during erection (see Appellants' Op. Br. pp. 25 and 26). No such device is employed by Downie or Evans.

In Morton, the ladder erecting mechanism is similar to the screw type mechanism shown in the back-in unit (see Appellants' Op. Br. pp. 20-24), which in the back-in unit contributed to its instability. The lever 50 in Morton, instead of being connected to a crosshead as in the Woody patent Exhibit 11 (see Appellants' Op. Br. p. 17), is connected to a piston rod (see Item 193, Figs. 1, 6 and 7 of Morton patent). Instead of hinging the lever 50 to the lower end of the ladder at a point on the ladder spaced from the hinge, the rod 50 is hinged to a plate 49 positioned at the bottom of the ladder. There is no evidence in this case that this form of connection has any function similar to that of the patented invention in producing a stable balance of forces.

IX.

Conclusion.

Cross-Appellant has not shown that the Trial Court's findings of fact are clearly erroneous. The Court's findings, conclusions and judgment as to the validity of the patent on the issues of law formulated by the Pretrial Order were correct and fully supported by the evidence. This evidence was that the patented device was a new combination which functioned in a different way from prior art portable derricks to give a stable, safe, legal, easily spotted, portable derrick, where prior art portable derricks were not stable, were not safe, were not legal and were difficult to spot. The problem solved by the patented unit was one long before the industry and the solution long desired. Cross-Appellants were originally very skeptical of the practicality of the drive-in principle. They made many other efforts to solve the problem and failed. They were finally forced by competition to copy the Moon design. This they did by obtaining a confidential bulletin prepared by Mr. Moon.

The drive-in principle has displaced the prior art portable derrick, outselling all other types. Cross-Appellees in their advertising have been complimentary of the "singular advance" made by the drive-in principle.

The prior art introduced on the issue of validity has no relation to the problem of portable oil well derricks. The only prior art which shows a portable telescopic derrick are the back-in units which have not been urged either at the trial or this appeal as prior art against the patent. The Downie and the Morton patents are simply irrelevant. The Evans patent is no better and is not competent evidence in this action. The advertisements are simply sketchy artist

presentations for sales purposes. They are not descriptive and lack the features which are important elements of the claims. The Court did not see the elements in the advertisements and did not believe Cross-Appellants' experts. It did not believe Mr. Purdum and Mr. Groner, who testified on direct that they saw the elements of the claims in the advertisements and whose testimony on cross-examination contradicted their testimony on direct. The Court's findings of fact are thus based, not only on the documentary evidence, but involved the credibility of witnesses' testimony and a resolution of conflict in the evidence.

We submit that the Cross-Appellants have not shown that upon the evidence in this record the Court's findings were clearly wrong. We submit that the evidence fully supports the Court's findings that the advertisements and the other pleaded prior art do not disclose the patented invention and that the patented invention is an inventive advance over the prior art.

While we believe the point to be moot, however, we have also shown that the advertisements are incompetent as evidence on the issue of anticipation, since they are less than a year prior to the filing date to which the patent in issue is entitled and are later than the date of invention.

We submit that this Court should affirm the Court's judgment that the patent and each claim thereof are good and valid in law.

Respectfully submitted,

PHILIP SUBKOW,

*In Propria Persona and Attorney for
Cross-Appellees.*



APPENDIX.

PUBLIC LAW 593, 82ND CONGRESS, SECOND SESSION,
CH. 950, 66 STAT. 792.

Sec. 4. (a) This Act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided. It shall apply to unexpired patents granted prior to such date except as otherwise provided.

(b) Section 102 (d) of Title 35, as enacted by section 1 hereof, shall not apply to existing patents and pending applications, but the law previously in effect, namely the first paragraph of R. S. 4887 (U.S. Code, title 35, sec. 32, first paragraph, 1946 ed.), shall apply to such patents and applications.

(c) Section 119, second paragraph, of Title 35 as enacted by section 1 hereof shall not apply to existing patents.

(d) The period of one year specified in section 102 (b) of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before August 5, 1940, and patents granted on such applications, and with respect to such applications and patents, said period is two years instead of one year.

(e) Nothing contained in Title 35, as enacted by section 1 hereof, shall operate to nullify any judicial finding prior to the effective date of this Act on the validity of any patent by a court of competent jurisdiction.

(f) Nothing in Title 35, as enacted by section 1 hereof, shall affect any provision of the Atomic Energy Act of 1946 (Aug. 1, 1946, ch. 724, 60 Stat. 755).

(g) The period of one year specified in section 4 of Title 35 as enacted by section 1 hereof shall not apply in the case of applications filed before the effective date of this Act.

(h) The repeal of sections 1-9, 11, 12 of the Act of Congress approved February 1, 1952 (ch. 4, 66 Stat. 3), shall not affect any rights or liabilities existing on the date of approval of this Act. An order of secrecy issued under or in effect under the repealed Act and in effect on the date of approval of this Act, shall be considered as issued under this Act, and any claims arising under the repealed Act or subject to presentation and determination pursuant thereto and unsettled as of the effective date of this Act, may be presented and determined pursuant to the provisions of this Act.

Sec. 5: The sections or parts thereof of the Revised Statutes or Statutes at Large enumerated in the following schedule are hereby repealed. Any rights or liabilities now existing under such sections or parts thereof shall not be affected by this repeal.

UNITED STATES CODE, TITLE 35; PATENTS

§ 101. Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. (R. S. 4886; 35 U. S. C., 1946 ed., 31.)

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication

in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was the first to conceive and last to reduce to practice, from a time prior to conception by the other. (R. S. 4886, 4887, 4923; 35 U. S. C., 1946 ed., 31, 32, 72.)

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section

102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

§ 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and it contains or is amended to contain a specific reference to the earlier filed application.

UNITED STATES CODE, TITLE 35; SECTION 31

§ 31. Inventions patentable

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and

not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. R.S. § 4886; March 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.

MANUAL OF PATENT EXAMINING PROCEDURE U. S.
PATENT OFFICE, DEPARTMENT OF COMMERCE, (EDITION
OF NOV. 15, 1949) 201.08 CONTINUATION IN PART

A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in the said earlier case. (In re Klein, 1930, C.D. 2: 393 O.G. 519)

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated in the case of a sole divisional application stemming from a joint application (201.06) and the further condition that the applicant present an exact line of division between matters of joint invention and sole invention. (In re Perrin, 1944 C.D. 380; 565 O.G. 151.)

For notation to be put on the file jacket by the Examiner in the case of a continuation-in-part application see 202.02.

201.11 Continuity Between Applications: When Entitled to
Filing Date

A division, continuation, or continuation-in-part is linked by co-pendency with the original or parent application; and contains, in whole or in part, identical disclosure

in common with the original application. Such applications are entitled to the effective filing date of the original application for only the common subject matter disclosed.

A division, continuation, or continuation-in-part may be filed at any time during the pendency of the parent application. Such continuing application may be filed, for example, after an appeal to the Board or to the Court, provided the parent application has not become abandoned (1215); or after the application has gone to issue (In re Febrey, 1943, C.D. 510; 554 O.G. 377). In the latter case the period of pendency includes the three months' extension when the final fee is paid and a three months' extension for the issuance of the patent is obtained.

* * *

202.02 Notation as to Parent Application on Jacket and and in File of a Divisional, Continuation, Continu- ation-in-Part, or Substitute Application

The identifying data of a parent or prior application must be given in the specification and must be inserted by the Examiner on the left margin of the file jacket in the case of a DIVISION, a CONTINUATION, or a SUBSTITUTE Application. The file jacket bears on the left hand margin, the legend: "Division of Application No....., filed....., 19....." This is to be filled in at the time of the first action with the serial number and date of any prior application of which the one in question is a division, a continuation, or a substitute, the word "Division" being replaced by *Continuation*, and the words "Division of" replaced by *Substitute for abandoned*, as may be required. If the prior application has issued as a patent, the patent number and date should also be supplied. If the application at hand is a division of a division,

the data of all cases involved should be given. (Order No. 1832, Revised.)

In the case of a continuation-in-part the identifying data of the parent or prior application must be given in the specification and the Examiner must stamp only the letter C--P. on the file jacket.

One of the reasons for these notations being put on the file jacket is that they indicate to the Docket Clerk when an application is a DIVISION, CONTINUATION, CONTINUATION-IN-PART or a SUBSTITUTE. These four types of applications must be sent to the Assignment Branch for a title search when in condition for allowance. (Order No. 3411, Revised.) See 306 for work done by the Assignment Branch pertaining to these particular types of applications.

Only the letters C--P. (without data) are placed on the file jacket in the case of a continuation-in-part because the printer does not use the data of the prior application in setting up the heading when printing a continuation-in-part patent.

WALKER ON PATENTS, DELLER'S EDITION

"The novelty required in order that an invention may be protected by a patent is that it must be new. Statements that some things are not patentable because, though new in a commercial sense, they are not new in the eye of the patent law, occur in a few reported cases. *Boston Pencil Pointer Co. v. Auto. Pencil Sharpener Co.*, 276 Fed. 910, C.C.A. 2 (1921). In every such instance, however, it would have been more accurate to say that some things are not patentable because, though new things, they are not invented things. Such things lack patentability not because they lack newness, but because they lack invention. *Boston Pencil Pointer Co. v. Auto. Pencil Sharpener Co.*,

supra; Aro Equip. Corp. v. Herring-Wissler Co., 84 F. (2d) 619, C.C.A. 8 (1936). The question belongs to the domain of invention and not to that of novelty, and it is therefore treated in the third chapter of this book. With this explanation, it is not untrue nor misleading to say that whatever is really new, is new in the eye of the patent law. Therefore in order to negative novelty or, as it is usually expressed, to "anticipate" an invention, it is necessary that all of the elements of the invention or their equivalents be found in one single description or structure where they do substantially the same work in substantially the same way. *Imhaeuser v. Buerk*, 101 U.S. 647, 660, 25 L.Ed. 945 (1879); *Bates v. Coe*, 98 U.S. 31, 25 L.Ed. 68 (1878); *Ottumwa Box Car Loader Co. v. Christy Box Car Loader Co.*, 215 Fed. 362, C.C.A. 8; *Ventilated Cushion & Spring Co. v. D'Arcy*, 232 Fed. 468, C.C.A. 6 (1916); *Dow Chem. Co. v. Williams Bros. Well Treating Co.*, 81 F(2d) 495, 501, C.C.A. 10 (1936); *Universal Oil Products Co. v. Winkler-Kock E. Co.*, 6 F.Supp. 763, 770, D.C., D. Del. (1934), *aff'd* 7 F. (2d) 991, C.C.A. 3 (1935)." (Vol. 1, pp. 254, 255.)

Alexander Anderson, Inc. v. Eastman (D.C.S.D. of Cal. C.D. 1936), 16 F. Supp. 513.

"Whenever printed publications, and particularly those in foreign languages, are relied upon as anticipations or to negative novelty in a method claim of a domestic patent, the publication must, within their four corners, clearly and fully describe the method claimed in the patent and under consideration, *Seymour v. Osborne*, 11 Wall. 516, 20 L.Ed. 33; *Permutit Co. v. Harvey Laundry Co.* (C.C.A.2) 279 F. 713, 718; *Permutit Co. v. Wadham* (C.C.A.6) 13 F. (2d) 454, 456; *Loew Filter Co. v. German-American*

Filter Co. (C.C.A.6) 164 F. 855; Naylor v. Alsop Process Co. (C.C.A.8) 168 F. 911, 917; Fulton Co. v. Bishop & Babcock Co. (D.C.) 17 F.(2d) 99." (P. 522)

Balaban et al. v. Polyfoto Corporation, 47 Fed. Supp. 472 at 477, 478.

"A device is new within the meaning of the patent laws unless all its elements can be found in a single prior description or structure where they do the same work in substantially the same way. *Chicago Lock Co. v. Tratsch*, 7 Cir., 72 F.2d 482, 487. As we have already pointed out, the prior art cited by the defendant in this case does not do the same work as the patent in suit and, consequently, not in substantially the same way. An invention is not anticipated by an accidental, incidental or unintentional use of some of its features unless the benefits or ensuing results from such use are appreciated or recognized. *Tilghman v. Proctor*, 102 U.S. 707, 711, 26 L.Ed. 279; *Edison Electric Light Co. v. Novelty Incandescent Lamp Co.*, 3 Cir., 167 F. 977, 980. The fact that, by transposing parts of the Wilson patent, the order of the Balaban invention can be obtained is not anticipation, for Wilson neither disclosed a combination such as the Balaban device nor did he appreciate the results to be obtained from such a combination." (p. 478)

Bianchi v. Barili (9th CA 1948), 168 F.(2d) 793, p. 796.

"In *Topliff v. Topliff and Another*, 145 U.S. 156, 161, 12 S.Ct. 825, 828, 36 L.Ed. 658, the Court said: 'It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.' " (p. 796)

Ralph N. Brodie Co. et al. v. Hydraulic Press Mfg. Co. (9th C.C.A. 1945), 151 F.2d 91.

“Both patents were regularly issued. Hence both patents and all claims thereof were presumptively valid.¹¹ Hence the burden of establishing the invalidity of claims 7, 9, 10, 11, 14 and 15 of patent No. 2,067,265 and claims 7, 8, 9 and 10 of patent No. 2,136,240 rested on appellants.¹²

All these claims were for combinations. Appellants alleged, in substance and effect, that these combinations were not new,¹³ and that therefore the claims were invalid for lack of novelty. The question thus presented was one of fact.¹⁴ On this question, appellants had the burden of proof.¹⁵

Appellants alleged, in substance and effect, that the combinations did not involve invention, but were merely the product of ordinary skill, and that therefore the claims were invalid for lack of invention. The ques-

¹¹*Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 7-10, 54 S. Ct. 752, 78 L. Ed. 1453; *Reinharts v. Caterpillar Tractor Co.*, 9 Cir., 85 F. 2d 628, 630.

¹²See cases cited in footnote 11.

¹³See §4886 of the Revised Statutes, 35 U. S. C. A. §31.

¹⁴*Battin v. Tagger*, 17 How. 74, 84, 15 L. Ed. 37; *Reckendorfer v. Faber*, 92 U. S. 347, 352, 23 L. Ed. 719; *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 312, 29 S. Ct. 495, 53 L. Ed. 805; *American Sales Book Co. v. Bullivant*, 9 Cir., 117 F. 255, 258; *Parker v. Stebler*, 9 Cir., 177 F. 210, 212.

¹⁵*Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171, 57 S. Ct. 675, 81 L. Ed. 983; *Parker v. Stebler*, *supra*; *San Francisco Cornice Co. v. Beyrle*, 9 Cir., 195 F. 516, 518; *Diamond Patent Co. v. S. E. Carr Co.*, 9 Cir., 217 F. 400, 402; *Los Angeles Lime Co. v. Nye*, 9 Cir., 270 F. 155, 163; *Schumacher v. Buttonlath Mfg. Co.*, 9 Cir., 292 F. 522, 531.

tion thus presented was one of fact.¹⁶ On this question, appellants had the burden of proof.¹⁷

On both questions,—the question of novelty and the question of invention—the evidence¹⁸ was conflicting. Resolving the conflicts in favor of appellee, the court found that the combinations were new, that they involved invention, and that therefore the claims were not invalid for lack of novelty or for lack of invention. These findings are supported by substantial evidence, are not clearly erroneous and should not be set aside.”¹⁹

In *Cold Metal Process Co. v. Carnegie-Illinois Steel Corporation*, (3rd C. C. A. 1939), 108 F. 2d 322, 323; *cert. den.* 309 U. S. 665; *op. withdrawn* upon *Stip.* 115 F. 2d 33.

“In considering the prior art as embodied in the many patents cited to show lack of novelty in Steckel’s combination, we here note case of *Skelly Oil Co. v. Universal Oil Products Co.*, 3 Ci., 31 F. 2d 427, 431, where, speaking for this court, Judge Woolley admirably stated the test as follows: ‘A patent relied upon as an

¹⁶*Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446, 44 S. Ct. 533, 68 L. Ed. 1098; *Stoody Co. v. Mills Alloys*, 9 Cir., 67 F. 2d 807, 812; *Reinharts v. Caterpillar Tractor Co.*, *supra*; *Wire Tie Machinery Co. v. Pacific Box Corp.*, 9 Cir., 102 F. 2d 543, 552; *Research Products Co. v. Tretolite Co.*, 9 Cir., 106 F. 2d 531, 534.

¹⁷*Hunt Bros. Fruit Packing Co. v. Cassidy*, 9 Cir., 53 F. 257, 259; *Reinharts v. Caterpillar Tractor Co.*, *supra*; *National Nut Co. v. Sontag Chain Stores Co.*, 9 Cir., 107 F. 2d 318, 333.

¹⁸The evidence consisted of 43 exhibits and the testimony of four witnesses. The exhibits included copies of the patents (Nos. 2,067,265 and 2,136,240) here involved and copies of 17 prior patents. The witnesses included appellee’s expert, Arthur M. Greene, Jr., and appellants’ expert, Alanson P. Brush.

¹⁹See Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723c (p. 94).

anticipation must itself speak. Its specification must give in substance the same knowledge and the same directions as the specification of the patent in suit. *Otto v. Linford*, 46 L.T. (N.S.) 35, 44. It is not enough to prove that a method or apparatus described in an earlier specification can be made to produce this or that result. *Flour Oxidizing Co. v. Carr & Co.*, 35 R.P.C. 457. A singularly sensible test of the rule of anticipation is given in *British Thomson-Houston Co. v. Metropolitan Vickers Electrical Co.*, 45 R.P.C. 22, by asking the question—"Would a man who was grappling with the problem solved by the patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand, have said: 'That gives me what I wish?'" *The Pope Alliance Corporation v. The Spanish River Pulp & Paper Mills, Ltd.* (Privy Council Appeals No. 33 of 1926).'

This was restated in this circuit in *Worthington Mower Co. v. Gustin*, 3 Cir., 80 F. (2d) 594, petition for certiorari denied, 297 U. S. 725, 56 S. Ct. 500, 80 L. Ed. 1008, and in *American Safety Table Co. v. Singer Sewing Mch. Co.*, 3 Cir., 95 F. 2d 543, 550, certiorari refused, 305 U. S. 622, 59 S. Ct. 82, 83 L. Ed. 397." (p. 323)

Diebold, Inc. v. Record Files, Inc., 114 Fed. Supp. 375 (1953) D. C. N. D. Ohio E. D.

"The application of the Patent Codification Act to pending suits and suits on unexpired patents instituted after January 1, 1953, its effective date, must depend upon the particular section of the Act invoked and whether the facts giving rise to a new claim or defense under the Act occurred after its effective date.

While it is true that there are expressions of opinion in the decisions of the courts and in the legislative history that the Act was intended to be a codification, only, of the existing law (see *Thys Co. v. Oeste*, D.C. 111 F. Supp. 665; *New Wrinkle, Inc., v. Watson*, D. C. Cir., 206 F. 2d 421, cited by defendant,) it also is clear that some substantive changes were enacted by the Congress.

"Section 253 relating to disclaimers and now under consideration is one instance of such change. See Reviser's note under this Section, and Section 1,321, amended Rules of Practice of the U S. Patent Office, 35 U.S.C.A. Appendix. Thus, under the new Section only a claim 'as a whole' may now be disclaimed.

"This change in the law relating to disclaimers cannot benefit the present defendant, however, for the disclaimer in this case was filed under the old statute. The constitutional principle of due process prohibits the retroactive application of the new statute and a resultant invalidation of the plaintiffs' patent claims." (p. 376)

Florence-Mayo Nuway Co. v. Hardy (4th C. C. A. 1948) 168 F. 2d 778.

"The combination of Mayo, then, was new and useful and not anticipated in the prior art. We think it unquestionably involved patentable invention and not the application of mere mechanical skill. It is easy to say now that what Mayo did was simple and obvious; but nobody seems to have thought of doing what he did until he did it. Knowledge after the event is always easy, and problems once solved appear as never having presented difficulty. We must try, however, to avoid the danger which Judge Evans has recently pointed out

of thinking there is no invention merely because we can understand a mechanism after it has been explained to us. *National Slug Rejectors v. A. B. T. Mfg. Co.*, 7 Cir., 164 F. 2d 333, 336. As said by Mr. Justice McKenna in the *Grant Tire Case*, 'the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration.' *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U.S. 428, 435, 31 S.Ct. 444, 447, 55 L.Ed. 527; *U. S. Industrial Chemical Co. et al v. Theroz Co.*, 4 Cir., 25 F. 2d 387; *Frick Co. v. Lindsay*, 4 Cir., 27 F. 2d 59. Applicable also is the following statement from the opinion in *Black & Decker Mfg. Co. v. Baltimore Truck Tire Service Corp.*, 4 Cir., 40 F. 2d 910, 914, where we said: 'To the presumption of validity attaching to the grant of the patent by the Patent Office, there is the additional presumption arising from the fact that the invention filled a want arising from a new situation, that it entered into immediate use, and that it met with pronounced commercial success. *Tenco Electric Motor Co. v. Apco Mfg. Co.*, 275 U.S. 319, 48 S.Ct. 170, 72 L.Ed. 298; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 31 S.Ct. 444, 55 L.Ed. 527; *Pangborn Corporation v. W. W. Sly Mfg. Co.*, 4 Cir., 284 F. 217. And in addition to this is the presumption arising from the imitation of the patented article by the manufacturer of the alleged infringing device. As to this, we agree with what was said by Judge Hough, speaking for the Circuit Court of Appeals of the Second Circuit in *Kurtz v. Belle Hat Lining Co.*, 280 F. 277, 281: "The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps espe-

cially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think.”

“See also *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 54 S.Ct. 593, 88 L.Ed. 721, and *Hoeltke v. C. M. Kemp Mfg. Co.*, 4 Cir., 80 F. 2d 912; *Brown and Sharpe Mfg. Co. v. Kar Engineering Co. Inc.*, 1 Cir., 154 F. 2d 48.” (p. 781 and 782.)

Grever v. United States Hoffman Co. (6th C. C. A. 1913) 202 F. 923.

“It was not merely a reversal of parts, but a discovery that, by the reversal of the parts, and adaptation that was simple enough after the reason for the change was observed, he could get a new result, and that the parts so combined would co-act in a different manner, and from such new co-action and such new result it follows there was invention.” (p. 925)

International Cellucotton Products Co. v. Sterilek Co., Inc. (2d C. C. A. 1938), 94 F. 2d 10.

“The validity of the other claims in suit, depends upon what the art had known. There had been a machine in use since 1910 or 1912—*Marcus*, No. 1,038,493—which made such pads by cutting sections of filler from a continuous web, depositing them upon a gauze web and folding the wrapper around them. The pads themselves were composite, being first built up out of two layers; and the mechanism for wrapping both the outer layer of the pads and the gauze, was in general the same as *Bauer’s*. This was the nearest reference in the immediate field, and to it we shall recur. However, the examiner cited against these claims, as well as against

claim 19, the "Johnson & Johnson machine," which we have just mentioned, but about whose structure the file-wrapper tells very little. To escape this reference Bauer limited the claims in suit to a machine in which the gauze ran at right angles to the filler web, just as he introduced into claim 19, the other clause just considered. The defendant bases its case very largely on the assumption that by so doing he conceded that the prior art anticipated the claims except for this interpolated feature. This has been sometimes said in the case of disclaimers, which are in substance limitations imposed after issue; but it is a mistaken view of the law. When an inventor consents to limit his monopoly, there is no reason in fact to impute to him the belief that his only patentable advance lies in the element so introduced. He may merely think that he still retains enough for practical purposes, and that the examiner's insistence does not justify the expense of an appeal. Nor is there any reason to impose upon him the same consequence as though he had formally so conceded; it is enough that he has freed the art except as the claim reads, and that he has surrendered any power under the doctrine of equivalents to resume what he has given up. He has done nothing which need prevent him from insisting in support of the claim as allowed that his invention was broader than the examiner supposed; he is not confined to the examiner's reasoning or committed to his mental processes. *United Chromium v. International Silver Co.*, 2 Cir., 60 F.2d 913, 915. We cannot therefore recognize the 'Johnson & Johnson machine' for any purpose whatever; it was not proved as a prior use, and until it was, the defendant might not rely upon it." (p. 12)

Jacuzzi Bros., Inc. v. Berkeley Pump Co., (9th C. C. A. 1951) 191 F. 2d 632.

"A true combination which performed a new function necessarily must be found as a whole in a prior patent or publication in order to accomplish destruction of a grant of monopoly. *Imhaeuser v. Buerk*, 101 U.S. 647, 660, 25 L.Ed. 945; *Adams v. Bellaire Stamping Co.*, 141 U.S. 539, 542, 12 S.Ct. 66, 35 L.Ed. 849." (p. 637)

Kirsch Mfg. Co. v. Gould Mersereau Co., Inc. (2d C. C. A. 1925), 6 F. 2d 793.

"* * * An invention is a new display of ingenuity beyond the compass of the routineer, and in the end that is all that can be said about it. Courts cannot avoid the duty of divining as best they can what the day to day capacity of the ordinary artisan will produce. This they attempt by looking at the history of the art, the occasion for the invention, its success, its independent repetition at about the same time, and the state of the underlying art, which was a condition upon its appearance at all. Yet, when all is said, there will remain cases when we can only fall back upon such good sense as we may have, and in these we cannot help exposing the inventor to the hazard inherent in hypostatizing such modifications in the existing arts as are within the limited imagination of the journeyman. There comes a point when the question must be resolved by a subjective opinion as to what seems an easy step and what does not." (p. 794)

Kurtz v. Belle Hat Lining Co. (2nd C. C. A. 1922), 280 F. 277.

"The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps

especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think. *David v. Harris*, 206 Fed. 902, 904, 124 C.C.A. 477; *Smith v. Peck* (C.C.A.) 262 Fed. 415, 417. Commercial success has been too recently and too often considered to justify much citation; but, however unsafe as a guide (*Boston, etc. Co. v. Automatic* [C.C.A.] 276 Fed. 910), it has always been a powerful piece of evidence, especially when the prior art shows no success along the same lines (*David v. Harris, supra*).” (p. 281)

In Lincoln Stores v. Nashua Mfg. Co., (1st C. C. A. 1946), 157 F. 2d 154; *cert. den.* 329 U. S. 811; 67 S. Ct. 623; 91 L. Ed. 692.

“The prior art will not anticipate a patent for a combination unless it discloses ‘all the elements of such combination, or their mechanical equivalents, functioning in substantially the same way to produce substantially the same result’; and a prior patent does not anticipate a subsequent patent where the prior patent failed to solve the problem which the subsequent patent solves successfully. *Williams Iron Works Co. v. Hughes Tool Co.*, *supra*, 109 F. 2d at page 506, 510.” (p. 160)

Loew Filter Co. v. German-American Filter Co. of N.Y. (6th C. C. A. 1908), 164 F. 855.

“Neither do we think the Zimmer article an anticipation of Stockheim’s first, second, or fourth claim. While Zimmer points out that ‘no air should be allowed to pass into the filter,’ and that a delivery of foamless beer from the outlet side of the filter is dependent upon there being ‘no air in the apparatus’ and a proper back pressure, yet he does not disclose how the admission of air is to

be prevented, or how air which may be originally in the apparatus, or which may enter during the operation, is to be expelled without passing through the filter, to the injury of the filter material as well as to the beer. Zimmer seems to refer chiefly to preventing the admission of air to the apparatus, meaning, probably, during the operation of filtering. Touching such admissions, he refers to the use of a well-known 'special contrivance provided to prevent this.' What this contrivance was, or how it operated, he does not tell us, nor have we any means of knowing. Prof. Mabery, an expert for appellants, gives it as his opinion that by this reference to the exclusion of atmospheric air he meant the 'luft sammler,' or air collector, which is attached to the large filter used by the Hammels at Socorro and described in Michel Brewery Book. The contrivance referred to by Zimmer can only be shown by evidence that it was either in known common use or had been described by some publication of which the general public must take notice. The Zimmer publication must be given effect as an anticipation only to the extent that it actually gave to the public information of a process of filtration. It is not competent to read into such a publication information which it does not give, or by expert opinion explain an otherwise uninforming statement by evidence of some apparatus or article not itself competent as an anticipation. *Badische Anilin & Soda Fabrik v. Kalle & Co.*, 104 Fed. 802, 44 C.C. 201." (p. 860)

Maulsby v. Conzevoy (9th C. C. A. 1947), 161 F. 2d 165.

"Appellee alleged, in substance and effect, that the methods described in the claims were not new, and that

therefore the claims were invalid for lack of novelty. The question thus presented was one of fact.²

"Appellee alleged, in substance and effect, that the methods described in the claims did not involve invention, but were merely the product of ordinary skill, and that therefore the claims were invalid for lack of invention. The question thus presented was one of fact.³

"On both questions—the question of novelty and the question of invention—the evidence was conflicting. Resolving the conflicts in favor of appellee, the court found that the methods were not new, that they did not involve invention, and that therefore the claims were invalid for lack of novelty and for lack of invention. These findings are supported by substantial evidence, are not clearly erroneous and should not be disturbed."⁴

J. A. Mohr & Son v. Alliance Securities Co., 14 Fed. 2d, 799.

"It is to be borne in mind that the prior art here relied upon consists entirely of patents, and that when

²*Battin v. Taggart*, 17 How. 74, 84, 15 L. Ed. 37; *Reckendorfer v. Faber*, 92 U. S. 347, 352, 23 L. Ed. 719; *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U. S. 301, 312, 29 S. Ct. 495, 53 L. Ed. 805; *American Sales Book Co. v. Bullivant*, 9 Cir., 117 F. 255, 258; *Parker v. Stebler*, 9 Cir., 177 F. 210, 212; *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, 9 Cir., 151 F. 2d 91, 94.

³*Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446, 44 S. Ct. 533, 68 L. Ed. 1098; *Stoody Co. v. Mills Alloys*, 9 Cir., 67 F. 2d 807, 812; *Reinharts v. Caterpillar Tractor Co.*, 9 Cir., 85 F. 2d 628, 630; *Wire Tie Machinery Co. v. Pacific Box Corp.*, 9 Cir., 102 F. 2d 543, 552; *Research Products Co. v. Tretolite Co.*, 9 Cir., 106 F. 2d 530, 534; *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, *supra*; *Crowell v. Baker Oil Tools*, 9 Cir., 153 F. 2d 972, 978.

⁴Rule 52(a) of the Federal Rules of Civil Procedure, 28 U. S. C. A. following section 723c; *Ralph N. Brodie Co. v. Hydraulic Press Mfg. Co.*, *supra* (p. 167).

it is sought by means of prior patents to ascertain the state of the art, 'nothing can be used except what is disclosed on the face of those patents. They cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.' *Naylor v. Alsop Process Co.*, 168 F. 911, 94 C.C.A. 315; *Frey v. Marvel Auto Supply Co.*, 236 F.916, 150 C.C.A. 178." (p. 800)

Patterson-Ballagh Corp. et al v. Moss et al (9th C. C. A. 1953), 201 F. 2d 403.

" * * * It is agreed that the spooler disclosed in the Moss patent shows every element of the Reed patent, except that in the Moss patent the spooler is suspended from a hinging line attached to an eye at the top of the spooler in such a manner as to enable the spooler to hang substantially parallel to the drilling line which passes through it. In the Reed patent the eye is placed in the middle or longitudinal center of the spooler. It is conceded that hanging the spooler from the middle eye causes greater pressure upon the drilling line from the spooler, and, therefore, more rapid wear. * * *" (p. 405)

"The Moss spooler represents one of the more recent efforts to deal with an old problem, that is, the problem of lateral whip of the drilling line between the crown block and the cylinder drum. Previous spoolers had succeeded at least to some extent in diminishing the whip of the cable. However, the Moss spooler, with its eye for the hanging line at the top, was the first spooler not only to diminish the lateral whip of the line but also to substantially eliminate the frictional wear on the line caused by the spooler itself when hung in a different manner, for example, from a middle eye as in the Reed patent.

" * * *

“It is quite apparent that simplicity alone will not preclude invention. Hindsight tends to color the seeming obviousness of that which in fact is true contribution to prior art. ‘Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention.’ *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 1911, 220 U.S. 428, 435, 31 S.Ct. 444, 447, 55 L.Ed. 527.

“If hanging a spooler from an eye at the top was obvious to one skilled in the art, including a practical man of the oil fields, we do not understand why appellants manufactured their spoolers with an eye in the middle from July 1936 to July 1937. There are other unanswered questions. If appellants finally changed the eye on their spoolers from the middle to the top in July 1937 in response to suggestions received from men working in the oil fields, as they allege, why were these men not brought forward to testify? If these suggestions were received in 1936 and 1937, why were they not incorporated in a patent application for a spooler filed by appellants in December 1936, and the Reed patent application filed in May 1937?

“ * * * * *

“Appellants had the burden of proof on the question of the validity of the Moss patent since a presumption of validity arises from the issuance of a patent. *Mumm v. Jacob E. Decker & Sons*, 1937, 301 U.S. 168, 171, 57 S.Ct. 675, 81 L.Ed. 983; *Radio Corporation of America v. Radio Engineering Laboratories, Inc.*, 1934, 293 U.S.

1, 7, 55 S.Ct. 928, 79 L.Ed. 163. Reasonable doubts must be resolved in favor of the validity of the patent. The presumption created by the action of the Patent Office is the result of the expertness of an administrative body acting within its specific field and can be overcome only by clear and convincing proof. The District Court found that the appellants had not met this burden of proof. It did not err." (p. 406)

Permutit Co. v. Harvey Laundry Co. (2d C. C. A. 1922) 279 F. 713, 719, *cert. den.* 259 U. S. 588.

"If prior patents and publications can be reconstructed by extraneous efforts to fit the exigency of the case, it would, as was said in *Badische Anilin & Soda Fabrik v. Kalle & Co.*, 104 Fed. 802, 44 C. C. A. 201, require an inquiry, not only as to what the publication communicates to the public, but 'it will be transferred to an endeavor to ascertain what its author intended to communicate.' We cannot read into this article what is not there, and which it would be necessary to obtain from the later development of the art in order to meet with appellee's success." (p. 719)

Pointer v. Six Wheel Corporation, (9th C. C. A. 1949), 177 F. 2d 153.

"A test which has been found very useful and generally followed is that adverted to by Mr. Chief Justice Taft in the case just referred to,—namely, the discovery of the source of the difficulty and the application of a remedy not thought of before. * * *

"Of course, if in solving the difficulty, the inventor merely does what would have been manifest to one skilled in the art, merely substitutes an obvious element

for another, or recombines old elements, there is no invention. * * *

“By the same token, invention cannot be defeated merely by showing that, in one form or another, each element was known or used before. * * *

“The question is: Did anyone before think of combining them in this manner in order to achieve the particular unitary result,—a new function? *If not, there is invention.* * * *

“At times, the result is accomplished by means which seem simple afterwards. But, although the improvement be slight, there is invention, unless the means were plainly indicated by the prior art.” (pp. 160-161)

Ex Parte Roberts, 1887 C. D. 61-64, 40 O. G., 573.

“On January 10, 1887, an application, Serial No. 217,-773, previously filed by applicant, was allowed, showing and describing a certain construction of a smoke-condenser, comprised of a number of parts, which, though they could be used together as a complete and practicable apparatus, were so far independent as to one or two of them that they could be used separately. The application was capable of division. One of these features, called the ‘globular revolving sprinkler,’ or ‘central chamber,’ had not been claimed specifically, though in the second claim it was mentioned in combination with another feature.

“On February 8, 1887, applicant petitioned the Commissioner for permission to withdraw the case from issue, and to amend by adding claims embodying this feature. The request was disapproved by the Examiner, and the Com-

missioner denied the petition upon the ground, stated in his decision, that applicant's remedy was to file a separate application for this feature of his invention. It will not escape notice that there was no reservation in the original application, and in this state of the case applicant had no other alternative but to rely upon a second application, which he did, filing the same on March 12, 1887, a few days before the patent in the original case issued. The Office required no cross-references and none were filed. The Examiner rejected this second application, holding that when two applications are pending, one showing but not claiming an invention *claimed* in the other, if cross-disclaimers are not filed under Rule 42, a patent issued upon the former application is a bar to the issuance of a patent upon the latter. He accordingly refused to consider the application, his decision being expressed as follows:

"The above application can not be considered, as applicant has failed to insert a disclaimer in application filed November 2, 1886, now Patent No. 360,052, as required by Rule 42. (See *Ex parte Ransom*, 39 O. G., 119.)

"From this decision applicant appeals to the Commissioner.

"Rule 42 provides that when there are two or more applications pending—
relating to the same subject-matter of invention, all showing but only one claiming the same thing, those not claiming it must contain disclaimers thereof, with reference to the application claiming it.

"But there is nothing in the rules, nor is there any statutory provision to the effect that a failure to file such dis-

claimer should deprive applicant of his right to a patent, or invalidate one issued upon the second application. The rule does not and could not constitute a statutory bar" (pp. 62-63).

* * * * *

"The action of the examiner is reversed, and the case is remanded, with directions to consider the application and to proceed in its consideration in accordance with the principles announced in this decision." (p. 64)

Safety Car Heating & Lighting Co., Inc. v. General Electric Co. (2d C.C.A. 1946), 155 F.2d 937.

"Courts made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and—perhaps most important of all—the extent to which it superseded what had gone before." (p. 939)

Stauffer v. Slenderella Systems of California (9th C.C.A. 1957), 254 F.2d 127.

"Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situa-

tion and united in the same way to perform the identical function in a prior pleaded patent, there is no anticipation.

"The advances in the prior art may be such that, although there is no strict anticipation and even though the devices involved may not be similar, a trained mechanic would, if presented with the problem, solve it without difficulty.² The court found affirmatively that the Stauffer device did not contain invention.

"There was a collateral question in the case introduced under the theory that imitation of a device is a pragmatic test of invention and that commercial success of a device is evidence of utility, and an inference of the existence of invention may also be found therein. This Court and other courts have used these factors as some evidence to sustain a finding of fact of patentability."³

In *Texas Co. v. Globe Oil & Refining Co.* (D.C. N.D. Ill. E.D. 1953), 112 F. Supp. 455; aff'd 225 F. 2d 725.

"In evaluating the prior art, it is to be considered from the standpoint of the men in the art at the time the invention was made, and may not be reconstructed in the light of

²"A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C.A. § 103. *Oriental Foods, Inc. v. Chun King Sales, Inc.* (9 Cir.), 244 F. 2d 909; *Schmeiser v. Thomasian* (9 Cir.), 227 F. 2d 875.

³"Commercial success may be taken into consideration in determining validity. The trend . . . is to use it as a makeweight only 'where the patentability question is close.' . . .

" . . . it is not a criterion . . . in determining whether there was invention." *Pointer v. Six Wheel Corporation*, (9 Cir.), 177 F. 2d 153, 156, and cases cited therein.

"But commercial success without invention will not make patentability. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 340 U. S. 147, 153, 71 S. Ct. 127, 130, 95 L. Ed. 162" (p. 128).

the present day knowledge; National Slug Rejectors, Inc. v. A.B.T. Mfg. Corporation, 7 cir., 1947, 164 F.2d 333. In considering the bearing of the patents and publications cited as prior art or anticipation, the basic question is what does the cited reference itself say—not what it might have said or what might be done with it by a present day expert, adding present day knowledge. Young Radiator Company v. Modine Mfg. Co., 7 Cir., 1931, 55 F.2d 545.” (p. 483) *Timken-Detroit Axle Company v. Eaton Axle & Spring Company*, (D.C., N.D. Ohio E.D. 1931) 56 F.2d 651

“ . . . The rule permitting the inventor to have the benefit of an earlier filing date, in the case of two applications, limits such advantage to subject matter common to both applications. I think the formalities of the application are not controlling where it may be fairly determined that the inventor was endeavoring to secure protection for the same idea in the latter as in the earlier application, and that the substantial features of his conception are disclosed in the earlier application. It is not essential that every detail be common to both.

“An examination of the two applications, with the attendant treatment and patent office history, justifies the finding and conclusion that Rockwell is entitled to the benefit of the earlier date. Disclosure was substantially made to those skilled in the art, in the earlier application, *though no reference appears by words in the latter*. I find that plaintiff is entitled to the benefit of November 6, 1922, as the date of application for the patent in suit.” (Emphasis added.) (pp. 651-652)

Trussell Mfg. Co. v. Wilson-Jones Co. (2nd C.C.A. 1931), 50 F.2d 1027.

"Concededly the best reference is the patent to F. Von Schlegel, issued in 1908. It is urged that this shows a binder having a back-plate embedded in flaps of the cover which must have been slitted or skived to received it. But this contention depends altogether upon the drawings and the hatchings which they show. We need not say that never in any circumstances could drawings alone be enough to prove an anticipation, though the language used in some of the cases might seem to go so far. See *A. R. Mosler & Co. v. Lurie*, 209 F. 364, 366 (C.C.A. 2); *Gray Telephone Pay Station Co. v. Baird Mfg. Co.*, 174 F. 417, 421 (C.C.A. 7). But even if drawings may at times be enough, the rule is perfectly settled, and it is a useful one, that to be an anticipation the disclosure must be clear. *Atlantic Gulf & Pac. Co. v. Wood*, 288 F. 148, 155 (C.C.A. 5); *Skelly Oil Co. v. Universal Oil Products Co.*, 31 F. (2d) 427, 431 (C.C.A.3); *Canda v. Mich. Malleable Iron Co.*, 124 F.486, 492 (C.C.A.6). Von Schlegel's patent does not meet this requirement. It is pure conjecture, and that merely from the drawings without the aid of any text, whether Von Schlegel meant what Trussell later disclosed, or meant only the familiar built-up type of cover.

"This is equally true of the German patent to Gebruder Friedrichs, which was not pleaded as a technical anticipation, but was offered in evidence to show the state of the art. The construction of this cover and back is even more difficult to conjecture than is Von Schlegel's. This dis-

closure is not sufficiently clear to satisfy the rule already mentioned. Indeed, it has been urged that that rule must be applied more strictly to foreign than to domestic patents. Much may be found in the books which seems to support such a distinction. See *Seymour v. Osborne*, 11 Wall. 516, 555, 20 L.Ed. 33; *Hanifen v. E. H. Godshalk Co.*, 84 F. 649, 651 (C.C.A. 3); *In re Ek*, 57 App. D.C. 203, 19 F. (2d) 677, 678. However, we see little basis for it. An inventor is charged with knowledge of whatever the prior art discloses, but the disclosure, to be an anticipation, must be clear and certain. Why it need be more clear in a foreign patent than domestic one, we confess is not obvious to us. But we need not now determine whether the distinction is too firmly established to be disregarded. We mention it merely by way of a caveat." (p. 1029)

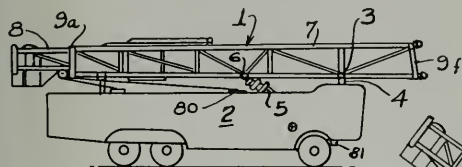


Fig. 1.

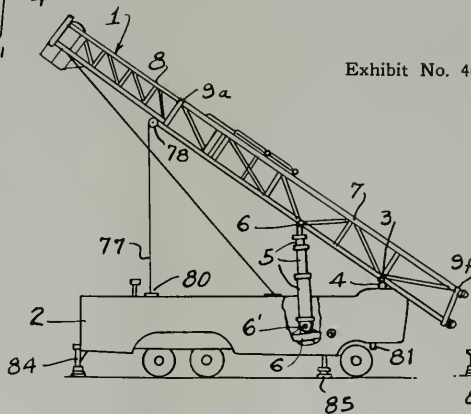


Fig. 2.

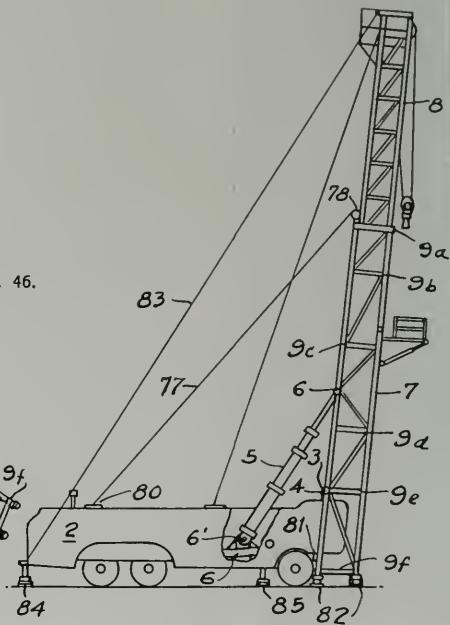


Fig. 3.

Exhibit No. 46.

JAMES MOON
INVENTOR.
BY
Wm. A. Dutton
ATTORNEY.

Pages 1-5 of Specification of Serial No. 10,412; filed Feb.
24, 1948 (Ex. 46)

SPECIFICATION

1. TO ALL WHOM IT MAY CONCERN:

Be it known that I, JAMES MOON, a citizen of the United States residing in Altadena, County of Los Angeles, State of California, have invented a new and
5. useful ERECTION AND EXTENSION MECHANISM FOR PORTABLE MASTS, of which the following is a specification:

Portable drilling and servicing rigs are commonly employed in the petroleum production for the drilling and servicing of wells. Such rigs are usually trans-
10. ported on trucks or trailers which carry a mast or derrick which may be positioned on the truck and erected at the drilling site. These masts are usually composed of one or more sections, usually two, in such form that the upper section may be telescoped
15. into the lower section when the derrick is to be transported, and upon erection of the lower section, by rotation of this section about a hinge point on the truck, the telescoped derrick may be withdrawn or extended from the lower section to give a mast of the desired
20. height. This type of mast for such purposes is now conventional and is described in Patent No. 2,204,713 and in my co-pending applications Serial Nos. 677,031 and 785,165.

Since such masts are called upon to carry tremen-
25. dous loads on the order of 200,000 pounds, it is important that when the derrick is extended the extensible portion be securely latched in position in the lower portion.

1. In a co-pending application, Serial No. 785,165, I have disclosed an automatic latching mechanism which is independent of the human element and acts to automatically latch the extensible section of the mast to the
5. lowermost section when the extensible mast section has reached a predetermined position in relation to the lower section during the extension thereof and will hold the upper section securely in position under all loads designed to be taken by the derrick, and will also
10. automatically unlatch and move into an inoperative position when the derrick is to be retracted and remain in that position during the retracton thereof.

It is a particular object of the present application to devise a mechanism for erecting the derrick from a

15. horizontal to a vertical position and also provide mechanism for extending the derrick during its erection.

- It is a further object of my invention to provide an elevating and erecting mechanism in which the telescoping derrick section, during elevation thereof from
20. a horizontal position on the truck to an erect position, is withdrawn. The force exerted on the telescoping section during the withdrawal thereof is supplied by its mechanism for erecting the derrick. The consequence of my erecting and elevating mechanism is that
 25. there is, during the erection thereof, a net reactive restoring force acting to move the derrick to horizontal position against the applied erecting force. Means are also provided whereby the weight of the telescoping section also acts as a restoring force to
 1. move the derrick to collapsed and horizontal positions and means for controlling this rate of collapse and restoration.

These objects are accomplished by hanging the telescoping section on a line fixed at one end to the derrick support and carried on the lower hinged section. Upon elevation of the lower section by rotation of the lower section on its hinge, the telescoping derrick is withdrawn.

10. I may elevate the derrick by means of any mechanism such as the screw and lever arrangement shown in Patent No. 2,204,716 or in my co-pending application Serial No. 691,717, filed August 20, 1946, but I prefer to employ a hinged hydraulic jack for this purpose. I
15. may thus erect and extend the derrick by extending the jack and because of the net restoring or reactive load I may, by bleeding the cylinder of the hydraulic jack, cause the derrick to collapse and settle back upon the derrick by means of the dashpot action of the
20. hydraulic jack.

These and other objects of my invention will appear clear from the following description taken together with the drawings, in which

- Fig. 1 is a side elevation, partly schematic, of the
25. extensible mast of my invention in its fully retracted position on the vehicle.

Fig. 2 shows the derrick in partly erected position;

Fig. 3 shows the derrick in fully erected position.

Fig. 4 is a schematic load and force diagram showing the forces acting on the erecting and extending mechanism;

1. Fig. 5 is a section taken along the line 5-5 of Figs. 6 and 7, showing also the valves and lines in schematic form;

Fig. 6 is a section taken along the line 6-6 of Fig. 5;

5. Fig. 7 is a vertical elevation of the derrick with parts broken away for a more clear showing;

Fig. 8 is a detail section taken along line 8-8 of Fig. 7;

- Fig. 9 is a section taken along the line 9-9 of Fig. 10, showing the details of the latching mechanism;

Fig. 10 is a section taken along line 10-10 of Fig. 9;

- Fig. 11 is a fragmentary detail of one of the legs of the extensible section showing the relationship between the legs and the valve actuating mechanism in one position.

Fig. 12 is similar to Fig. 11, but showing the valve actuating mechanism in another position; and

Fig. 13 is a section of the jack erecting mechanism.

- Derrick 1 may be mounted upon truck 2 in any conventional manner, such as shown in Patent No. 2,204,713 or in my co-pending application Ser. No. 691,717, where it is usually mounted upon the end of the truck, or may be mounted upon the front of the truck, as is shown in my co-pending application Ser. No. 776,631, filed September 29, 1947.

- The derrick or mast is hingedly mounted at 3 (adjacent the lower end of the lower section)* upon a pair of trusses 4, one mounted upon each side of the truck 2 whose chassis forms a platform on which the mast is mounted. The derrick or mast is retracted onto the platform or is erected by rotation around hinge 3 by an extensible jack 5 which is hingedly connected to derrick 1 at 6 and to truck 2 at hinge 6'. Such connection of the extensible hydraulic jack 5 for the erection

*Inserted by amendment 5/9/52.

and retraction of the derrick is conventional and is shown in the aforementioned patent.

The derrick 1 is composed of a lower section 7 and

5. an upper section 8 which is telescoped into section 7 when the derrick is retracted, and may be extended from section 7 to an elevated position as shown in Fig. 3. Lower section 7 is separated into a number of panel sections by horizontal box girders 9a to 9f, inclusive, 9a forming the top girder of the lower section and 9f forming the lowermost girder thereof. These girders connect the front legs 12 and 13 and the rear legs 10 and 11 of the lower section, as shown in Figs. 5 and 6.
15. Mounted on the front end of each of the box girders adjacent the front legs 12 and 13 are guide channels 14 which extend between each of the adjacent box girders 9a to 9f, inclusive. These are connected to the box girders in the manner shown most clearly in Fig. 20.
20. 6. At each of the box girders adjacent each of the legs 10, 11, 12, and 13 is a semi-circular channel member 13' welded to the box girders and connected to the legs 10, 11, 12, and 13, respectively, by a gusset 13a. Circular guide channels 14 are connected (by welding) by spacers 15 to the channels 13' to provide a space between the channels 14 and 13' for purposes to be described hereinbelow.

The front legs of the upper telescoping section, shown at 17, are guided in the channel member 14 mounted adjacent the front legs 12 and 13, and the back legs 18 of the telescoping inner section are mounted and guided in guide channels 14 mounted adjacent the rear legs 10 and 11. The inner section

